

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1, 2, 4 and 6-11 remain in the application and claims 1 and 9 are independent.

The Office Action dated June 4, 2009 has been received and carefully reviewed. Each issue raised in the Office Action is addressed below. Reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Examiner Suggestion

Applicants note that the rejection for lack of enablement appears to have been converted to a request in paragraphs numbered 3-5, for Applicants to identify the corresponding structure of the “control means” of claim 1, so the Examiner may evaluate the definiteness requirement. The Examiner has already provided his interpretation of the display means and print-specifying information setting means on pages 2 and 3. For the record, Applicants note that display means, print-specifying information setting means and control means were all terms present in original claim 1 of the application as filed and are therefore a part of the original specification. Moreover, Applicants note that the control means provides the functions recited in claim 1, which include the displaying of image data with and without print-specifying information associated with the images so they may be distinguished, which function along with the print-specifying information setting means is provided, *inter alia*, by means of increment and decrement buttons 5 and 6, execution button 7 for executing various processes, mode setting dial 8, as shown in the Figures of the drawings, and the structure which is implicit in the disclosure and would have been clear to those skilled in the art. Note that MPEP § 2181 specifically provides, in part, that:

“[t]he disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. See *Id.* at 1380, 53 USPQ2d at 1229; *In re Dossel*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997).

Under certain limited circumstances, the written description does not have to explicitly

describe the structure (or material or acts) corresponding to a means- (or step-) plus-function limitation to particularly point out and distinctly claim the invention as required by 35 U.S.C. 112, second paragraph. See *Dossel*, 115 F.3d at 946, 42 USPQ2d at 1885. Under proper circumstances, drawings may provide a written description of an invention as required by 35 U.S.C. 112. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991). Rather, disclosure of structure corresponding to a means-plus-function limitation may be implicit in the written description if it would have been clear to those skilled in the art what structure must perform the function recited in the means-plus-function limitation. See *Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374, 1379, 53 USPQ2d 1225, 1228 (Fed. Cir. 1999) (stating that the "one skilled in the art" analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation and that the USPTO's recently issued proposed Supplemental Guidelines are consistent with the court's holding on this point); *Dossel*, 115 F.3d at 946-47, 42 USPQ2d at 1885 ("Clearly, a unit which receives digital data, performs complex mathematical computations and outputs the results to a display must be implemented by or on a general or special purpose computer (although it is not clear why the written description does not simply state 'computer' or some equivalent phrase.)").

Thus, as requested by the Examiner, the specification has been reviewed to ensure that it sets forth requisite structure of the claimed means plus function language, including the "control means", and Applicants respectfully submit that under the standards set forth in § 2181 referenced by the Examiner, the control means in claim 1 meets the definiteness requirement of claim 1.

Claim Rejections – Written Description

Claims 1 and 9 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action indicates that the amendment phrase "prior to the digital image data being read out of the storage medium for printing" presented March 6, 2009 contains subject matter which was not described in the specification in such a way as to reasonably convey that the Applicants had possession of the claimed invention at the time the application was filed. The rejection is respectfully traversed.

The Examiner points to instances where it appears the specification "uses the past tense to describe when an image with associated print-specifying information is displayed", referring to "printed state" and "frames that are printed". Applicants submit that when the entire

application disclosure is carefully considered *in toto*, it should be clear that Applicants were in possession of the claimed invention, and that the allegedly confusing phrases do not support a rejection under 35 U.S.C. § 112, first paragraph.

It appears that this rejection may be predicated upon the failure of the specification to include the exact language “prior to the digital image data being read out of the storage medium for printing”. Among other places, MPEP § 2163 describes the written description requirement, which is in its essence the requirement that applicant be in possession of what is claimed at the point of the filing of the application. It is submitted that there is clear support for the above noted claimed features for the following reasons. First, MPEP § 2163 makes clear that “there is no *haec verba* requirement”, only that “newly added claim limitations be supported in the specification through express, implicit or inherent disclosure.” Here the phrase “prior to the digital image data being read out of the storage medium for printing” merely carries the meaning defined by the words – that the display is used to indicate which images are to be printed, that is “to be used during printing” in the words of original claim 9 and “total number of print sheets to be used in printing” in the words of original claim 12. Thus, the specification text at page 10, line 22 through page 11, line 5 and page 11, lines 17-21, when read in light of the remainder of the specification, support displaying the print-specifying information “to be used during printing” in the words of original claims 9 and 12.

The specification as filed also makes clear on pages 10 and 11 that increment and decrement buttons 5 and 6 are used for “changing the number or order sheets”, which is consistent with the use of these buttons to create order information “to be used during printing”, again in the words of original claim 9. It would not make any sense to change the number of sheets to be printed after the sheets were already printed.

MPEP § 2163 states further that “The claims as filed in the original specification are part of the disclosure and, therefore, if an application as originally filed contains a claim disclosing material not found in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. CIR. 1985).” Should the Examiner require it, Applicant would have no objection to adding the phrase or phrases identified by the Examiner to the specification.

Claim Rejections - 35 U.S.C. § 102

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(e) as anticipated by Kawamura. Applicants submit that the Examiner has failed to establish a *prima facie* case of anticipation and respectfully traverse the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the cited reference must teach or inherently include each and every element of the claims. See MPEP § 2131; MPEP § 706.02.

The Office Action takes the position on page 6 that column 9, lines 50-60, of Kawamura anticipates the requirement that the digital image data having print-specifying information and not having print-specifying information are displayed on the display prior to the digital image data being read out of the storage medium for printing. It appears that the Examiner is interpreting the reference feature in which Kawamura displays a number of transfer icons that corresponds to the number of times the transfer has occurred before all of the transfers have occurred, as meeting the claim. Applicants respectfully submit that these claims do not read on the process or structure described in the reference. Kawamura merely shows that the same number of icons (51 and 52) as the number of completed transmissions are displayed. The change in display only occurs after, and as a result of, the data transmission. Note in particular Figure 4, which shows the transfer mode flow, which indicates at steps S9 and S11, and again at steps S14 and S16, that the icon is not applied until after the transfer has finished. Thus the icons are not used as displaying a number which indicates how many copies of a photograph a user wishes to print or are to be printed. And, thus the icons are not applied before any of the digital image data is read out of the camera storage medium for printing. Reconsideration and allowance are respectfully requested.

Claim Rejections – 35 U.S.C. §103(a)

Claims 2, 6, 7, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kawamura in view of Honda. Applicants submit the Examiner has failed to establish a *prima*

facie case of obviousness and respectfully traverses the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. See MPEP § 706.02(j); MPEP §§ 2141-2144.

Honda has been cited to show printing-specifying information, such as a number of print sheets, displayed with the recorded image on the camera display as appears in Figures 30A, 30C, 31, 32A and 32B. To the contrary, we note that Honda only discloses presenting a full frame image with all of the printing-specifying information for every image. Honda never discloses or suggests displaying digital image data of a number of thumbnail images at the same time in the camera display. Honda never discloses or suggests displaying images for which printing-specifying information was set and digital image data with no printing-specifying information so they may be discriminated from each other when they are displayed on said displaying means prior to the digital image data being read out of the storage medium for printing, and therefore Honda cannot remedy the defects of Kawamura discussed above. The secondary reference to Honda neither discloses nor suggests simultaneous display of both kinds of images prior to the image data being read out of the storage medium, as recited in amended claims 1 and 9, from which claims 2, 6, 7, 10 and 11 depend. Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 2, 6, 7, 10 and 11.

Claim Rejections - 35 U.S.C. §103, including Hanzawa

Claims 4/1 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kawamura in view of U.S. Pat. No. 5,506,661 to Hanzawa. Claim 4/2 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Kawamura in view of Honda and Hanzawa.

Hanzawa was cited for showing a display of only the printing-specifying data on the display and for displaying a printing price value on the display. To the contrary, we note that Hanzawa is not directed to the display on a digital camera as claimed, but to the display on a mimeographic production printing apparatus as show in Figure 1 and as described in column 3,

lines 15-22 and column 4, lines 33-39. Hanzawa merely calculates and displays the price for a mimeograph order using the apparatus in Figure 3 and the flow chart of Figure 4. Hanzawa provides no teachings or suggestions related to images stored in a digital camera. Hanzawa does not supply the missing features of claim 1 that are lacking from Kawamura. Moreover, it is not clear how one might combine the disclosures of Kawamura and Hanzawa since Hanzawa is not directed to a digital camera at all, but is instead directed to the display for mimeographic apparatus. Such an apparatus cannot display a digital photograph at all and can only display print control parameters. The rejection is silent as to what would create a nexus that would connect such disparate prior arts. Claims 4 and 8 are additionally submitted to be allowable for the reasons set forth above regarding claim 1 for the further features claimed therein.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

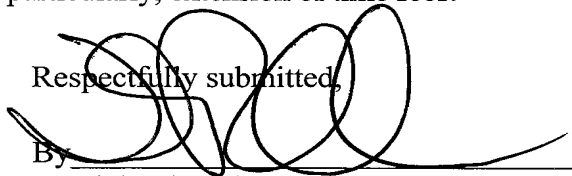
Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,



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